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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/492,173	01/27/2000	Hideki Ito	2298/3	9525

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EXAMINER

PATTERSON, MARC A

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/492,173

Applicant(s)

ITO ET AL.

Examiner

Marc A Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

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DETAILED ACTION

WITHDRAWN REJECTIONS

1. The 35 U.S.C. 112 second paragraph rejection of Claims 7 – 29, of record on page 2 of the previous Action, are withdrawn.

NEW REJECTIONS

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 7 – 10, 15, 20, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda et al (U.S. Patent No. 4,985,538) in view of Shibuya et al (U.S. Patent No. 5,270,390).

With regard to Claims 7 – 10, 13, 18, 20, 23, 25 and 28, Fukuda et al disclose a heat shrinkable polyester film (column 6, lines 37 – 49) for making a label having a bonded portion (the film is used as a label of bottles; column 1, lines 10 – 19). Fukuda et al fail to disclose a film comprising 50 weight percent to 99.9 weight percent thermoplastic polyester resin and 0.1 weight percent to 50 weight percent polyester resin.

Shibuya et al teach a composition comprising 50 weight percent to 99.9 weight percent thermoplastic polyester resin and 0.1 weight percent to 50 weight percent polyester resin in a heat shrinkable polyester film (column 3, lines 29 – 41) for the purpose of making a heat

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shrinkable film having superior gas barrier property and cold resistance (column 3, lines 25 – 28).

One of ordinary skill in the art would therefore have recognized the advantages of providing for a composition comprising 50 weight percent to 99.9 weight percent thermoplastic polyester resin and 0.1 weight percent to 50 weight percent polyester resin in Fukuda et al, which is also a heat shrinkable polyester film.

It therefore would have been obvious for one of ordinary skill in the art at the time Applicant's invention was made to have provided for a composition comprising 50 weight percent to 99.9 weight percent thermoplastic polyester resin and 0.1 weight percent to 50 weight percent polyester resin in Fukuda et al in order to make a heat shrinkable film having superior gas barrier property and cold resistance as taught by Shibuya et al.

Fukuda et al also fail to disclose a film having a shrinkage of 10 – 40% in the main shrinkage direction in water at 70 degrees Celsius for 5 seconds, and a film having a shrinkage of 50% or more in the main shrinkage direction in water at 95 degrees Celsius for 5 seconds, and a film having a shrinkage of 10% or less in the direction perpendicular to the main shrinkage direction in water at 95 degrees Celsius for 5 seconds. However, Fukuda et al disclose a film having a shrinkage of 30% or more in the main shrinkage direction when the film is put in water at 95 degrees Celsius for 5 seconds (column 6, lines 50 – 58), and a film having a shrinkage of 20% or less in the direction perpendicular to the main shrinkage direction when the film is put in water at 75 degrees Celsius for 5 seconds (column 6, lines 50 – 58). Therefore, the shrinkages would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end use of the product. It therefore would be obvious for one of

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ordinary skill in the art to vary the shrinkage, since the shrinkage would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as shown by Fukuda et al. *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

With regard to the claimed aspect of the film being a 'cap sealing label,' the film is used as a label for bottles as discussed above. The claimed aspect of the film being a 'cap sealing label' therefore reads on Fukuda et al.

With regard to the claimed aspect of the film having an adhesive retention of 95% or more after shrinkage, as determined after samples are produced by the process of applying 1,3-diioxane to a width of 2 mm on one side of the film at a first edge, the claimed aspect is given little patentable weight as it appears to be directed to a desired result of the invention, rather than a structural limitation. Furthermore, the scope of the claims falls within the limitations of Fukuda et al and Shibuya et al as discussed above. The method of making the film (product – by – process) is given little patentable weight.

With regard to Claim 15, the film haze is 10% (column 5, lines 13 – 24) and the thickness is 50 μm (column 15, lines 60 – 61).

4. Claims 14, 19, 24 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda et al (U.S. Patent No. 4,985,538) in view of Shibuya et al (U.S. Patent No. 5,270,390) and further in view of Yoshinaka et al (U.S. Patent No. 4,996,291).

Fukuda et al disclose a heat shrinkable polyester film for making a label having a bonded portion as discussed above. With regard to Claims 14, 19, 24 and 29, Fukuda et al fail to disclose a label which is a cap – sealing label.

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Yoshinaka et al teach that labeling and cap sealing are equivalent as articles comprising a heat shrinkable polyester film (column 1, lines 15 – 32) for the purpose of making an article which attaches closely as a wrapping (column 1, lines 17 – 32).

It therefore would have been obvious for one of ordinary skill in the art at the time Applicant's invention was made to have provided for a label which is a cap – sealing label in Fukuda et al in order to make an article which attaches closely as a wrapping as taught by Yoshinaka et al.

ANSWERS TO APPLICANT'S ARGUMENTS

5. Applicant's arguments regarding the 35 U.S.C. 103(a) rejection of Claims 7 – 10, 15, 20 and 25 as being unpatentable over Fukuda et al (U.S. Patent No. 4,985,538) in view of Shibuya et al (U.S. Patent No. 5,270,390) and 35 U.S.C. 103(a) rejection of Claims 14, 19, 24 and 29 as being unpatentable over Fukuda et al (U.S. Patent No. 4,985,538) in view of Shibuya et al (U.S. Patent No. 5,270,390) and further in view of Yoshinaka et al (U.S. Patent No. 4,996,291), of record in the previous Action, have been carefully considered but have not been found to be persuasive for the reason set forth below.

Applicant argues, on page 9 of Paper No. 15, that Fukuda et al discloses a shrinkage of 49% after 5 seconds at 49%, which is outside the range of the claimed invention. However, as stated above, Fukuda et al disclose a film having a shrinkage of 30% or more in the main shrinkage direction when the film is put in water at 95 degrees Celsius for 5 seconds (column 6, lines 50 – 58), and a film having a shrinkage of 20% or less in the direction perpendicular to the main shrinkage direction when the film is put in water at 75 degrees Celsius for 5 seconds

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(column 6, lines 50 – 58). Therefore, the shrinkages would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end use of the product. It therefore would be obvious for one of ordinary skill in the art to vary the shrinkage, since the shrinkage would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as shown by Fukuda et al. *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

Applicant also argues on page 9 that there would be no motivation to combine Fukuda with Shibuya because their teachings may be contrary to each other; Shibuya teaches enhancement of cold resistance, Applicant argues, whereas Fukuda teaches warm water resistance, sufficient shrinkage and solvent resistance. However, the properties of warm water resistance and cold resistance are not necessarily contrary; furthermore, as stated above, Shibuya et al teach a composition comprising 50 weight percent to 99.9 weight percent thermoplastic polyester resin and 0.1 weight percent to 50 weight percent polyester resin in a heat shrinkable polyester film for the purpose of making a heat shrinkable film having superior gas barrier property. The desirability of providing for a blend of a non – elastomeric polyester and an elastomeric polyester in Fukuda, which is a heat – shrinkable film, would therefore be obvious to one of ordinary skill in the art.

One of ordinary skill in the art would therefore have recognized the advantages of providing for a composition comprising 50 weight percent to 99.9 weight percent thermoplastic polyester resin and 0.1 weight percent to 50 weight percent polyester resin in Fukuda et al.


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Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Patterson, whose telephone number is (703) 305-3537. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached at (703) 308-4251. FAX communications should be sent to (703) 872-9310. FAXs received after 4 P.M. will not be processed until the following business day.

Marc A. Patterson, PhD.

Marc Patterson
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HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

11/14/03